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PATENT

ATTORNEY DOCKET No. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/385,394 Confirmation No.: 9093
Applicant: John S. Yates, Jr., et al.
Title: COMPUTER WITH TWO EXECUTION MODES
Filed: August 30, 1999 Art Unit: 2183
Atty. Docket: 114596-03-4000 Examiner: Richard Ellis

**RENEWED PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. § 1.136(b)**

Mail Stop DAC
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant renews the petition for an extension of time to file an Appeal Brief.

37 C.F.R. § 1.136(b) provides as follows:

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. ... Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).

In a Decision on Petition of 5/4/2004 (page 3), this Petitions Office expressly instructed that the appropriate procedure for preserving an issue for review, in spite of agency delays, was a Petition for Extension of Time Pursuant to 37 C.F.R. § 1.136(b). This Petitioner acted in reliance on those instructions, and filed such a Petition on December 1, 2005.

A Decision of 2/10/06 of the T.C. Director disagreed with this Petitions Office, and dismissed the Petition as "moot." Strikingly, the T.C. Director cited no authority for any

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on April 10, 2006 as First Class Mail in an envelope with sufficient postage addressed to Mail Stop DAC, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



definition of "moot." The examiner's paper of 2/15/06 demonstrates that at least the examiner believes the issues are still live, and not moot.

A. Sufficient Cause Exists for an Extension of Time

The Petition for Extension of Time should be granted because the PTO, through failure to observe written agency procedures and Federal Circuit procedural law, has created a situation in which proper adjudication of an issue of premature finality of final rejection (MPEP § 706.07(c) and (d)) must be adjudicated before the status of the case can be determined and a meaningful appeal brief on the merits can be prepared or filed. As of today, Petitioner believes the claims filed 4/25/05 are properly pending, and the examiner believes otherwise.

A Petition for Review of Premature Final Rejection was filed on 4/25/2005. Though the T.C. decides most issues in 4 to 10 weeks, this petition was not decided for **seven months** (continuing a trend of very lengthy delays in deciding petitions directed to premature final rejection). A paper was sent by SPrE Brian Johnson on 9/9/2005, however, that paper was beyond Mr. Johnson's authority. In a telephone interview of 10/30/2005, T.C. Director Harvey agreed that the 9/9/2005 paper was issued without agency authority, and would have to be reissued. After further papers were exchanged, a supplemental decision of the T.C. Director was issued 2/10/06. However, even this February 2006 Decision misquotes the petition, reframes issues, and ignores agency and court precedent, and cites no authority for most of the legal principles applied. As a practical matter, the petition filed in April 2005 has still not been decided under the law.

The time to seek further review of final rejection within the PTO under ordinary rules has expired, at no fault of this applicant, and only an incomplete and legally inadequate decision has been rendered to determine what claims are currently pending. An extension of time is warranted.

B. A Reasonable Time for Extension, and Requests for Related Relief

Action by the Office on the merits should be suspended until all issues raised in the Petition to the Director Regarding Premature Final Rejection filed herewith are fully and fairly

adjudicated. *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005) ("In accordance with the Administrative Procedure Act, the agency must assure that an applicant's petition is fully and fairly treated at the administrative level...").

In the event that the Petition to the Director Regarding Premature Final Rejection filed herewith is denied, Applicant should have two months to seek further review in the Office and/or District Court or to file an Appeal Brief or RCE; time periods within the Office should be extendable under Rule 136(a).

In the event that the Petition to the Director Regarding Premature Final Rejection is granted, the finality of the Office Action of 10/25/2005 is withdrawn, and prosecution may resume on an ordinary footing.

The petition fee of \$ 200.00 was previously charged, however the Petition as framed was not decided. It is thus believed that no further fee is due. In the event any fee is required, please charge the fee to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,
WILLKIE FARR & GALLAGHER LLP

Dated: April 10, 2006

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